REMARKS/ARGUMENTS

Claims 1-27 have been canceled and new claims 28-43 have been added. Support for new claims 28-43 is found in the specification, e.g., at pages 19-21, e.g., in Examples 14-17. No new matter has been added.

Anticipation Rejection

Claims 25-27 were rejected under 35. U.S.C. 102(b) as allegedly anticipated by Kalvoda (U.S. 4,619,921). Although claims 1-27 have been canceled, rendering moot the anticipation rejection as to these claims, Applicants submit that Kalvoda likewise does not anticipate any of new claims 28-43, and traverse to the extent that the anticipation rejection is applied prospectively.

Kalvoda does not teach any of Forms I-VI of the claimed invention. Example 5, the only example in Kalvoda that describes recrystallizing halobetasol, explicitly states that the melting point of the recrystallized product is 220-221 °C. By contrast, the crystalline forms of halobetasol propionate recited in the claims of the present application melt in a different range. For instance, crystalline halobetasol propionate Forms I and IV of the present invention undergo phase transition at 90 °C and 120-130 °C, respectively, to produce halobetasol propionate of crystalline Form III of the present invention, which melts at 205.8-209.0 °C. In addition, crystalline halobetasol propionate Forms V and VI of the present invention undergo phase transition at 90-100 °C and 150-170 °C, respectively, to produce halobetasol propionate of crystalline Form II of the present invention, which melts sharply at 214.5-215.0 °C. None of the crystalline forms of halobetasol propionate in the pending claims have a melting point as described in Example 5 of Kalvoda. As such, Kalvoda itself makes it clear that the crystalline halobetasol propionate described therein is different from any of the crystalline forms recited in the claims of the present application.

Further, Kalvoda does not enable one of ordinary skill in the art to produce any of Applicants' crystalline Forms I-VI. "To anticipate, the reference must ... enable one skilled in the art to make and use the claimed invention." *Bristol-Meyers Squibb Co. v. Ben Venue Lab., Inc.* 246 F.3d 1368, 1374 (Fed. Cir. 2001). "Even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling."

Paperless Accounting, Inc. v. Bay Area Rapid Transit Sys., 804 F.2d 659, 665 (Fed. Cir. 1986).

Example 5 of Kalvoda does not disclose any solvent ratios or recrystallization conditions and much less using the solvent systems and conditions taught by the present application for preparing the recited crystalline forms of halobetasol propionate. Perhaps even more telling is the fact that Example 5 of Kalvoda discloses a melting point (which indicative of crystal structure) clearly different from the melting points exhibited by Applicants' crystalline forms. Accordingly, Kalvoda is not enabling for any of Applicants' crystalline Forms I-VI. For at least the foregoing reasons, Kalvoda does not anticipate the claimed invention.

Obviousness Rejection

Claims 1-27 have been rejected under 35 U.S.C. 103(a) as allegedly obvious in light of Kalvoda in combination with Brittain, H.G. (Reference I: Polymorphism in pharmaceutical solid, Drugs and the pharmaceutical sciences, v. 95, 1999, chapter 6, pg. 227-240) and Brittain, H.G. (Reference II: Polymorphism in pharmaceutical solid, Drugs and the pharmaceutical sciences, v. 95, 1999, chapter 6, pg. 348-361). Although the obviousness rejection is rendered moot by the cancellation of claims 1-27, Applicants contend that these references do not render obvious current claims 28-43, and traverse to the extent that the obviousness rejection is applied prospectively.

Three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. See MPEP § 2143. See also *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In the instant case, the cited art fails to meet the foregoing requirements and, hence, fails to establish a prima *facie case* of obviousness. For the reasons discussed above,

Kalvoda does not disclose the claimed crystalline forms of halobetasol propionate, and, in any event for the reasons discussed herein, is not enabling with respect to the claimed invention. Brittain 1 describes methods of detecting polymorphs, and Brittain 2 describes the relationship between pressure associated with tableting procedures and changes in polymorph structure. However, neither Brittain 1 nor Brittain 2 teach or suggest halobetasol propionate polymorphs, and much less any of the crystalline forms of halobetasol propionate recited in the claims of in the present application. Hence, there is no motivation to combine Kalvoda, Brittain 1 and Brittain 2, and such disclosures do not provide a reasonable expectation of success. The Office has failed to explain, without using an impermissible degree of hindsight, why one of ordinary skill in the art would have been motivated to select the foregoing references and combine them to render obvious the crystalline forms of halobetasol propionate as recited in the pending claims.

The combination of cited references as a whole does not disclose or suggest any of the crystalline forms of halobetasol propionate recited in the pending claims. As discussed above, Kalvoda fails to teach or suggest crystalline halobetasol propionate in any of Forms I-VI as recited in the pending claims. Likewise, Brittain 1 and Brittain 2 fail to teach or suggest polymorphs of halobetasol propionate at all, and much less any of the crystalline forms of halobetasol propionate recited in the pending claims. Hence, the combination of Kalvoda, Brittain 1 and/or Brittain 2 fails to teach or suggest all of the elements recited in the pending claims. For at least the foregoing reasons, the claimed invention is not obvious in view of the cited references.

Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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